

REMARKS

I. STATUS OF CLAIMS

Claims 1-17 and 19-99 are pending. Claims 2-16 and 96-98¹ are withdrawn from consideration for being drawn to non-elected subject matter. No claim is amended herein.

II. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

Claims 1, 17 and 19-95 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 80-186 of co-pending U.S. Application No. 10/784,909. Office Action at p. 5.

In addition, claims 1, 17 and 19-95 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-41 of co-pending U.S. Application No. 10/849,825 in view of U.S. Patent No. 5,919,468 to Bara ("Bara '468"). *Id.* at p. 6.

As noted above, both of the obviousness-type double patenting rejections are "provisional" rejections. According to M.P.E.P. § 804(I)(B)(1):

If a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejection on other grounds, the examiner should withdraw the rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

¹ The Office Action Summary incorrectly indicates that claim 99 is withdrawn. Applicants note that on October 3, 2006, in Response to the July 3, 2006, Restriction of Requirement, Applicants elected to prosecute claims 1, 17-95 and 99. Thus, claim 99 is not withdrawn from consideration and should have been examined by the Examiner.

The present application, U.S. Application No. 10/603,698, was filed on June 26, 2003, while the '909 application was filed on February 24, 2004, and the '825 application was filed on May 21, 2004. Since the present application is the earlier filed of the co-pending applications, and Applicants have overcome the other grounds of rejections for the reasons discussed below, Applicants respectfully request that the Examiner withdraw the "provisional" non-statutory obviousness-type double patenting rejections over the '909 and '825 applications and allow the present application to issue without requiring that a terminal disclaimer be filed in this application.

III. REJECTIONS UNDER 35 U.S.C. § 103

A. Hanna et al. (U.S. Patent No. 5,843,417)

Claims 1, 17, 19-42, 49 and 70-95² are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. ("Hanna"). Office Action at p. 8. Applicants submit that the claimed invention is not obvious in view of Hanna for the reasons of record as well as the additional reasons set forth below.

Applicants maintain that the Examiner has not established a *prima facie* case of obviousness over Hanna. In order to meet the initial burden of establishing a *prima facie* case of obviousness, the Examiner first must show that the prior art reference teaches or suggests all the claim limitations. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Here, the Examiner has failed to meet this burden because Hanna fails to teach or suggest all the elements of the present claims. Indeed, at page 10 the Examiner admits that "Hanna et al. do not specifically teach that the W/O

² Based on the Examiner's previous rejection, which has been maintained in the present Office Action, it appears the Examiner intended to include claim 99 in the rejection under 35 U.S.C. § 103(a) over Hanna.

emulsion contains a C₈-C₂₂ alkyl dimethicone copolyol and another copolyol is present in an amount ranging from 5% to 10% by weight.” Accordingly, the teachings of Hanna are not sufficient to render the present claims *prima facie* obvious.

In addition, Applicants submitted a Declaration under 37 C.F.R. § 1.132 (“Declaration”) executed by Ozée Emmanuelle on December 8, 2008, which demonstrated that a foundation according to the claimed invention has improved results, in terms of homogeneity and stability, as compared with compositions comprising an amount of dimethicone copolyol outside the range of 5-10% by weight recited in present claim 1. See Declaration at ¶ 11.

The Examiner dismisses Applicants’ Declaration and asserts that

[w]hile the submitted data indicate the claimed foundation is more stable than other foundations that are outside the 5-10% range, the results are not viewed as unexpected results since Hanna et al. teach that W/O emulsions preferably contain one or more surfactants to stabilize the emulsion. Furthermore . . . Hanna et al. teach concentrations of the oil surfactant that lie within the range in the claimed instant application. Based on the prior art, one of ordinary skill in the art would be motivated to use the range taught by Hanna et al. to obtain a stable W/O emulsion. As such Applicant’s observed results are not unexpected and the claimed W/O emulsion would be expected to have improved stability based on the knowledge and teachings of the prior art (Hanna et al.).

Office Action at p. 4.

It therefore appears that the Examiner is not persuaded by the data submitted in the Declaration because the Examiner does not believe that the Declaration provides a direct comparison between the claimed invention and the invention disclosed in Hanna. Applicants respectfully disagree.

Inventive composition 1 in the Declaration comprises 0.8% by weight cetyl dimethicone copolyol, 5% by weight of dimethicone copolyol (which is within the claimed range of 5% to 10% by weight relative to the total weight of the emulsion), and 0.6% by weight of polyglycerylisostearate.

Comparative composition B in the Declaration comprises 0.8% by weight cetyl dimethicone copolyol, 4% by weight dimethicone copolyol, and 0.6% by weight polyglyceryl isostearate³. This comparative composition is representative of a composition disclosed in Hanna.

At col. 4, lines 56-57, Hanna discloses that the disclosed compositions preferably comprise one or more surfactants; at col. 5, lines, lines 3-7, Hanna discloses examples of oil surfactants, including dimethicone copolyol, cetyl dimethicone copolyol, and polyglyceryl-4-isostearate; and at col. 5, lines 29-31, Hanna discloses that the total amount of oil surfactant is from 5 to 15% by weight. The total amount of oil surfactant in comparative Composition B is 5.4% by weight, which is thus within the teachings of Hanna. Hanna notably does not teach or suggest an emulsion comprising 5% to 10% by weight dimethicone copolyol. Therefore, comparative Composition B comprises 4% by weight dimethicone copolyol relative to the total weight of the emulsion, an amount within the teachings of Hanna, but outside the claimed range of 5% to 10% by weight.

The viscosity of Example 1 and comparative Composition B was initially measured after 24 hours. The results revealed that the viscosity, and thus the stability of Example 1 was significantly higher than comparative Composition B. After 2 months

³ Each of the oil surfactants in comparative Composition B are listed as examples of oil surfactants in Hanna. See col. 5, lines 3-7.

at room temperature, Example 1 and comparative Composition B were analyzed under a microscope to examine their homogeneity and stability. The results revealed that the composition of Example 1 is a homogeneous emulsion with very small droplets of water whereas the emulsion of composition B was not homogeneous and had large droplets of water. This testing establishes that there is unpredictability resulting from the amount of dimethicone copolyol present in the composition. Thus, a foundation having superior homogeneity and stability cannot be predicted, with any reasonable expectation of success, based on the teachings of Hanna.

Because of the lack of predictability, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness based on Hanna. The unpredictability demonstrated in the Declaration undercuts the unsupported expectation regarding stability that is asserted by the Examiner. See, e.g., Office Action at p. 4.

In view of the foregoing, Applicants submit that the rejection of claims 1, 17, 19-42, 49, 70-95 and 99 under § 103 is improper and should be withdrawn.

B. Hanna in view of Elm et al. (U.S. Patent No. 4,552,753)

Claims 43-47 and 53-69 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17, 19-42, 49 and 70-95 above, and further in view of U.S. Patent No. 4,552,753 to Elm et al. ("Elm"), and as evidenced by the Aldrich Catalog 2003-2004. Office Action at p. 12. Applicants respectfully disagree and traverse the rejection for the reasons of record and for the additional reasons discussed below.

As discussed above, the teachings of Hanna are not sufficient to render claims 1, 17, 19-42, 49, 70-95 and 99 *prima facie* obvious. Moreover, the Examiner concedes that Hanna does not teach the particular volatile linear and/or cyclic silicone oils of the presently rejected claims, nor the flash points of said volatile silicone oils. Office Action at p. 12. The Examiner relies on Elm to cure these additional admitted deficiencies. However, Elm does not and cannot cure the deficiencies of Hanna set forth above. Likewise, the Aldrich Catalog does not teach or suggest anything to rectify the deficiencies of Hanna and Elm either. Thus, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw this rejection.

C. Hanna in view of Bara et al. (U.S. Patent No. 6,224,851)

Claims 48 and 50-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17, 19-42, 49 and 70-95 above, and further in view of U.S. Patent No. 6,224,851 B1 to Bara et al. ("Bara '851"). Office Action at p. 14. Applicants respectfully disagree and traverse the rejection for the reasons of record and for the additional reasons discussed below.

As discussed above, the teachings of Hanna are not sufficient to render claims 1, 17, 19-42, 49, 70-95 and 99 *prima facie* obvious. Moreover, the Examiner concedes that Hanna does not teach the particular volatile fluorinated oils of the presently rejected claims. The Examiner relies on Bara '851 to cure this additional admitted deficiency. Office Action at p. 14. However, Bara '851 does not cure the deficiencies of Hanna set forth above. Thus, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw this rejection.

III. CONCLUSION

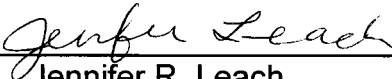
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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